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| 10/681,505 | 10/07/2003 | Vincent J. Zimmer | 42P17246 | 9647 |

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

BUTLER, DENNIS

ART UNIT PAPER NUMBER

2115

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/681,505

Applicant(s)

ZIMMER ET AL.

Examiner

Dennis M. Butler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 and 21-31 is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. This action is in response to the amendment received on June 22, 2006. Claims 1-31 are pending.
2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Applicant's original specification does not provide antecedent basis for the term "tangible". Therefore, the specification fails to provide the meaning of the term "tangible" as used in claims 21-23 and 30-33. See MPEP 608.01(o).
3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 11-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are directed to a machine accessible medium containing code that causes functions to be performed at some future time when the code is executed. Applicant has defined the medium as a carrier wave in paragraph 28 of the published application. Therefore, the claims are directed to an electro-magnetic signal, a carrier wave, which is a form of energy. The claims recite a signal encoded with functional descriptive material. The signal is nonstatutory because it is a form of energy and it does not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. 101.

The rejection would be overcome if applicant amended the claims to recite a machine readable storage medium in order to indicate that the medium was directed to the memory and disk devices listed in paragraph 28 of the published application.

In the remarks, applicant argues that the phrase "tangible" makes clear that the medium is a tangible medium. However, applicant's original specification does not provide antecedent basis for the term "tangible". Therefore, the specification fails to provide the meaning of the term "tangible" as used in claims 32-47. See MPEP 608.01(o). Since applicant may give a term used in the claims a special meaning, the examiner and the public cannot determine how the term "tangible" limits the claims. The examiner has maintained the rejection because the term "tangible" is not considered to exclude electro-magnetic signals, carrier waves, electrical, optical and acoustical signals as described in paragraph 33 of the published application. However, the claim language would be improved if the medium were claimed as a machine accessible storage medium in order to indicate that the claimed medium includes the storage media/devices described in paragraph 33 and excludes the electro-magnetic signals, a carrier waves, electrical, optical and acoustical signals as described in paragraph 33 of the published application. The examiners position is consistent with the Office guidelines for examination of patent applications for patent subject matter eligibility published October 26, 2005. The guidelines are based on the USPTO's current understanding of the law and are believed to be fully consistent with

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binding precedent of the Supreme Court, the Federal Circuit and the Federal Circuit's predecessor courts. The guidelines address claims directed to electromagnetic signals in annex IV (c), pages 55-57. Regarding applicant's argument that the claims are directed to a statutory article of manufacture, the Supreme Court has read the term "manufacture" in accordance with its dictionary definition to mean "the production of articles for use from raw or prepared materials by giving these materials new forms, qualities, properties or combinations, whether by hand-labor or by machinery". *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which, in turn, quotes the *Century Dictionary*). The definition requires physical substance that the claimed signals do not have. Therefore, the claims are not directed to a statutory article of manufacture. Regarding applicant's argument that steps of "converting", "applying", "determining" and "comparing" are physical process steps that transform one physical, electrical signal into another. The rejected claims do not recite any of these process steps. The examiner did not reject any of applicant's method claims under 35 USC 101. The rejected claims are directed to a carrier wave itself. The claims recite a signal, not method steps. The signal includes functional descriptive material (instructions). However, the claim clearly recites that these instructions are for running a process to boot a computing system. This is merely a field of use limitation that describes the field/system in which the functional descriptive material is intended to be used. As described in the above

rejection, the claim is directed to a signal comprising instructions that cause functions to be performed at some future time when the instructions are executed by the computing system. The claimed signal itself is not capable of performing the recited functions. The recited instructions must be running (executing) on the computing system using a combination of software and hardware to perform the recited functions. The recited functions are merely a description of the functional descriptive material, not method steps that are being performed. Therefore, there are no physical process steps that transform the electrical signal recited in the claims.

5. Applicant's arguments filed on June 22, 2006 have been fully considered but they are not persuasive for the reasons described above in paragraph 4.
6. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis M. Butler whose telephone number is 571-272-3663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dennis M. Butler

Dennis M. Butler
Primary Examiner
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